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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,841	08/23/2001	Dennis Thomas Gilham	5058	5479
26936	7590	06/07/2005		
SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910			EXAMINER SHERR, CRISTINA O	
			ART UNIT 3621	PAPER NUMBER

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/934,841	<b>Applicant(s)</b> GILHAM, DENNIS THOMAS	
	<b>Examiner</b> Cristina Owen Sherr	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This communication is in response to the applicant's amendment filed March 2, 2005. Claims 1-10 have been canceled. Claims 11-13 remain pending in this case.

***Response to Arguments***

2. Applicant's arguments with respect to claims 11-13 have been considered but are moot in view of the new ground(s) of rejection.

***Double Patenting***

3. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,308,165 B1.

4. Regarding claim 11 –

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 1 of U.S. Patent No. 6,308,165 B1 recites:

- a method of generating a postal indicia for a series of mail items
- determining a period of time
- storing a postage value relating to postage charges dispensed in said period of time
- providing postage data including said postage value
- generating a modified key relating specifically to a mail item by utilizing the secret key and postage data, above
- generating an authentication code by utilizing said modified key and said postage data

- printing said postage data and said authentication code as a postal indicium on said mail item

5. Claim 1 of U.S. Patent No. 6,308,165 B1 differs since it further recites additional claim limitation generating a second modified key and second authentication code based on the first key and authentication for use in a second piece of mail. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 6,308,165 B1 by removing limitations directed to the second mail piece. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969).

Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

6. Claims 12 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,308,165 B1 in view of Bird (US 5,428,353).

7. Regarding claim 12 –

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 2 of U.S. Patent No. 6,308,165 B1 recites:

- a postage meter apparatus for printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code
- clock means operative to determine a period of time in which postal indicia are to be printed on a plurality of mail items;

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- a register for storing a postage value relating to postage charges dispensed in said period of time;

- memory means for storing a secret key;

electronic control means

- input means operable to input item data relating to a mail item to said electronic control means, wherein said electronic control means is configured to generate a modified key relating specifically to said mail item by utilizing said secret key and postage data including said item data and said postage value, and generate an authentication code by utilizing said modified key and said postage data

8. Claim 2 of U.S. Patent No. 6,308,165 B1 differs since it further recites additional claim limitation generating a second modified key and second authentication code based on the first key and authentication for use in a second piece of mail. However, it would have been obvious to a person of ordinary skill in the art to modify claim 2 of U.S. Patent No. 6,308,165 B1 by removing limitations directed to the second mail piece. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969).

Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

9. Regarding claim 13 -

10. Claim 2 of U.S. Patent No. 6,308,165 B1 differs since it fails to recite a register for storing value of credit and wherein said postage data includes said value of credit.

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Bird teaches a register with keeps track of customer credit. (e.g. Col 1 ln 40 – col 4 ln 55).

11. It would be obvious to a person of ordinary skill in the art to combine the teachings of U.S. Patent No. 6,308,165 B1 and Bird in order that only mail which for which there are sufficient funds receives postal indicia.

12. It is further noted that claims 11-13 serve only to broaden U.S. Patent No. 6,308,165 B1, rather than to bring new limitations.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al (US 6,249,777).

15. Regarding claim 11 –

Kara discloses a method of printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including the steps of storing a secret key; determining a period of time in which postal indicia are to be printed on a plurality of mail items (fig 2, see user password); storing a postage value relating to postage charges dispensed in said period of time (see, e.g. fig 3, 304); providing postage data including said postage value (see, e.g. fig 3, 305); generating a modified key relating specifically to a mail item by utilizing said secret key and said postage data;

generating an authentication code by utilizing said modified key and said postage data; and printing said postage data and said authentication code as a postal indicium on said mail item (e.g. col 4 ln 5-40).

16. Although the steps in Kara are not exactly the same and in the same order as the steps in the instant application, a mere re-ordering of steps does not constitute patentable material.

17. Regarding claim 12 –

Kara discloses a postage meter apparatus for printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including: clock means operative to determine a period of time in which postal indicia are to be printed on a plurality of mail items (e.g. col 8 ln 2-15, any array of memories); a register for storing a postage value relating to postage charges dispensed in said period of time; memory means for storing a secret key; electronic control means; and input means operable to input item data relating to a mail item to said electronic control means; wherein said electronic control means is configured to generate a modified key relating specifically to said mail item by utilizing said secret key and postage data including said item data and said postage value, and generate an authentication code by utilizing said modified key and said postage data (e.g. col 4 ln 5-40; e.g. col 8 ln 2-15, any array of memories).

18. Although the steps in Kara are not exactly the same and in the same order as the steps in the instant application, a mere re-ordering of steps does not constitute patentable material.

19. Regarding claim 13 –

Kara discloses postage meter apparatus as claimed in claim 12, including: a further register for storing a value of credit; and wherein said postage data includes said value of credit (e.g. col 8 ln 2-15, any array of memories; fig. 3, valid funding).

20. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied, to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part.

#### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

22. Sansone et al (US 4,998,204) discloses a mailing system and method for low volume mailers printing postage information upon inserts.

23. Pagel et al (US 6,889,214) discloses a virtual security device.

24. Leon (US 6,424,954) discloses a postage metering system.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

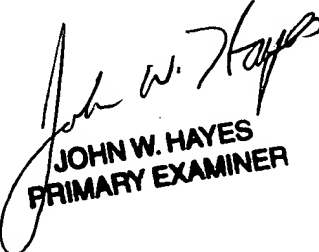


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26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOHN W. HAYES  
PRIMARY EXAMINER